

## REMARKS

### Introductory Comments

As of the mailing date of the 04/10/2009 Office Action, claims 17-21 and 23 were pending in the present application. In the present amendment, claim 17 has been amended, leaving claims 17-21 and 23 for consideration upon entry of the present Amendment. The claims have been amended as explained below. Reconsideration and allowance of the claims is respectfully requested in view of the foregoing amendments and the following remarks.

### Claim Amendments

Claim 17 has been amended to superscript the "1" in "R<sup>1</sup>" of the chemical structure, thereby correcting an error that was inadvertently introduced via Applicants' 06/04/2008 Response and restoring the form of the chemical structure presented in Applicants' 12/12/2004 Preliminary Amendment.

### Anticipation or Obviousness Rejections over Zuckert

Claims 17-20 and 23 stand rejected under 35 U.S.C. § 102(b), as anticipated by or under 35 U.S.C. § 103(a) as obvious over Zuckert et al. (US 3,979,346). 04/10/2009 Office Action, page 2, fourth paragraph (anticipation rejections); page 7, second full paragraph (obviousness rejections). Applicants respectfully traverse these rejections.

U.S. Patent No. 3,979,346 to Zuckert et al. (hereinafter "Zuckert") generally describes emulsion systems for preparing aqueous dispersions of alkyl resins, aqueous dispersions of alkyl resins, and a process of making the dispersions. Zuckert abstract. The emulsion system comprises an aqueous medium containing 0.5 to 3 percent by weight ammonia and (A) at least one non-ionic emulsifier, the hydrophobic part containing two or more radicals of unsaturated fatty acid and/or fatty alcohol with an iodine number of between 130 and 200, and the hydrophilic part containing polyethylene glycol chains and/or monomethoxypolyethylene glycol chains with from 6 to 100 ethylene oxide units; and (B) at least one anionic emulsifier, the hydrophobic part

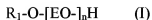
containing two or more radicals of unsaturated fatty acid and/or fatty alcohol with an iodine number of between 130 and 200, and the hydrophilic part including carboxylic groups. *Id.*

Applicants respectfully assert that claims 17-20 and 23 are neither anticipated by nor obvious over Zuckert because Zuckert does not teach or suggest an emulsion containing Applicants' claim 17 ether alcohol.

Anticipation requires that all of the limitations of the claim be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all limitations of the claim be taught or suggested by the prior art. *See, e.g., CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

Applicants' claim 17 – the only independent claim – is directed to an ether alcohol/polyol-in-oil emulsion comprising at least one ether alcohol of the general formula (I)



where  $R^1$  is  $C_{1-3}$ -alkyl,  $n$  is on average 7 to 15, and EO is building blocks derived from ethylene oxide, in an oil-immiscible ether alcohol/polyol phase, an oil phase and at least one emulsifier. Zuckert does not teach or suggest an emulsion containing Applicants' claim 17 ether alcohol. To the extent that Zuckert mentions "monomethoxypolyethylene glycols", these compounds are not present in an emulsion and are instead used as reactants to form the component (A) nonionic emulsifier. Zuckert abstract; column 2, lines 62-68; column 3, lines 55-58, 59-61; column 3, line 67 to column 4, line 3; column 6, lines 16-22. Note also that Zuckert's nonionic surfactants include fatty acid residues and maleic anhydride residues that are excluded from Applicants' claim 17 ether alcohol.

Thus, Zuckert does not teach or suggest an emulsion containing Applicants' claim 17 ether alcohol, and Zuckert accordingly neither anticipates nor renders obvious Applicants' claims.

Applicants therefore respectfully request the reconsideration and withdrawal of the rejection of claims 17-20 and 23 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) over Zuckert.

Obviousness Rejections over Mather

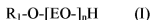
Claims 17-21 and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mather et al. (WO 96/39119). 04/10/2009 Office Action, page 4, third paragraph. Applicants respectfully traverse this rejection.

International Publication No. 96/39119 of Mather et al. (hereinafter "Mather") generally describes a solubilized topical composition of azelaic acid in a glycol base which is stable at normal temperatures and pressures and which is useful as a commercial substitute for dispersed azelaic acid preparations. Mather abstract.

Applicants respectfully assert that claims 17-21 and 23 are not obvious over Mather because Mather does not teach or suggest the use of Applicants' claim 17 ether alcohol specifically containing, on average, 7 to 15 building blocks derived from ethylene oxide.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all limitations of the claim be taught or suggested by the prior art. *See, e.g., CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

As noted above, Applicants' claim 17 – the only independent claim – is directed to an ether alcohol/polyol-in-oil emulsion comprising, in relevant part, at least one ether alcohol of the general formula (I)



where  $R^1$  is  $C_{1-3}$ -alkyl,  $n$  is on average 7 to 15, and EO is building blocks derived from ethylene oxide. That “ $n$ ” is on average 7 to 15 is an explicit limitation of the claim. Mather does not teach or suggest this limitation. Although Mather refers to “methoxypolyethylene glycol” at page 4, line 28 and page 6, line 9, Mather is silent with respect to the number of ethylene glycol units in the molecule. The Office has acknowledged this deficiency. 04/10/2009 Office Action, page 6, lines 1-2. Accordingly, Mather does not teach or suggest Applicants’ claim limitation that “ $n$ ” is on average 7 to 15. Furthermore, Applicants’ respectfully disagree with the Office’s assertion that “the skilled artisan would deem the use of methoxypolyethylene glycol with 7 ethylene oxide units a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.” It is well established that a parameter must first be recognized as result-effective before its optimization can be deemed routine experimentation. MPEP 2144.05(II)(B) (“A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.”). Here, Mather is silent on the number of ethylene glycol repeat units in his methoxypolyethylene glycol, and there is no suggestion in Mather that the number of ethylene glycol repeat units is a result-effective variable. Accordingly, its optimization is not a matter of routine experimentation.

In sum, Applicants’ claims specifically require 7 to 15 building blocks derived from ethylene oxide in their ether alcohol, and Mather does not teach or suggest this limitation. Mather therefore fails to support a prima facie case of obviousness against the present claims. Applicants therefore respectfully request the reconsideration and withdrawal of the rejection of claims 17-21 and 23 under 35 U.S.C. § 103(a) over Mather.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is respectfully requested.

It is believed that all the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' Attorneys.

Respectfully submitted,

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